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EXAMINER

WINTER, JOHN M

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WAYNE M. DORAN

Appeal 2009-009107
Application 10/022,957
Technology Center 3600

Decided: April 29, 2010

Before, ANTON W. FETTING, JOSEPH A. FISCHETTI, and BIBHU R.
MOHANTY, *Administrative Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant seeks our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 48, 49, 50, 53, 57-60. We have jurisdiction under 35 U.S.C. § 6(b)(2002).

SUMMARY OF DECISION

We AFFIRM.

THE INVENTION

Appellant claims an improved approach to issuing certified checks.

(Specification 3:2-3)

Claim 48, reproduced below, is representative of the subject matter on appeal.

48. A computer implemented method by a financial institution, the method comprising, by a server associated with the financial institution:

receiving from a check payor a request for a validation number yet to be generated and then associated with a check to be presented from the check payor to a check payee;

determining if an account contains sufficient funds to cover the monetary amount of the check to be presented from the check payor to the check payee;

generating a validation number when the account contains sufficient funds to cover the monetary amount of the check to be presented from the check payor to the check payee, wherein the validation number is randomly generated by the financial institution; and

issuing the generated validation number to the check payor to allow the check payor to associate the generated validation number with the check to be presented to the check payee.

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Chang	US 5,884,22	Mar. 16, 1999
Talati	US 5,903,878	May 11, 1999
Bozeman	US 6,754,640 B2	Jun. 22, 2004

The following rejection is before us for review.

The Examiner rejected claims 48, 49, 50, 53, 57, 58, 59, and 60 under 35 U.S.C. § 103(a) over Chang in view of Bozeman and Talati.

ISSUE

Has Appellant shown that the Examiner erred in rejecting claims 48, 49, 50, 53, 57, 58, 59, and 60 on appeal as being unpatentable under 35 U.S.C. § 103(a) over Chang in view of Bozeman and Talati on the grounds that a person with ordinary skill in the art would understand that Talati in disclosing issuing a UTID validation number when the client credit line is sufficient to cover the monetary amount of the transaction to be processed constitutes a determination by a financial institution of sufficient funding for a payment?

PRINCIPLES OF LAW

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 550 U.S. at 407 (“While the sequence of these questions

might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

FINDINGS OF FACT

We find the following facts by a preponderance of the evidence:

1. Chang discloses

When the payor 202 authorizes payment of a specified electronic bill 502 (i.e., when the payor authorizes immediate payment or when the current date matches the previously authorized payment data for an electronic bill), the payor bank 206 checks that the payor's account has sufficient funds to cover the bill payments and debits the payor's account accordingly. The payor bank 206 then generates one or more electronic checks 504 on behalf of the payor 202. Each electronic check is digitally signed by the payor bank 206 and transmitted to the payee 208 designated by the corresponding electronic bill, preferably in electronic check envelopes. (Chang, col. 7 ll. 19-30).

2. Talati discloses

In an alternative embodiment parties other than the originator 50 may create the UTID, for example the TA 60. A system and method for this type of transaction are illustrated in FIGS. 7 and 8. Initially, client 50 generates at processor 70, a credit authorization request including an originator identifier and relevant information to credit authority (CA) 60 at step 200. The CA 60 processes the credit request to determine the validity of the client 50 requesting credit based on the originator identifier and the associated amount at step 205. The CA 60 then sends

the credit transaction information along with an associated UTID or a rejection of authorization back to client 50 at step 210. Upon receipt of credit approval and the UTID, the client 50, transmits a purchase request with the provided UTID to the merchant 55 at step 15. (Talati, col. 6 ll. 61-67, col. 7, ll. 1-8).

ANALYSIS

We affirm the rejections of claims 48, 49, 50, 53, 57, 58, 59, and 60 under 35 U.S.C. § 103(a).

Initially, we note that the Appellant argues independent claims 48, 49, 53, 57, 58, and 59 together as a group. Correspondingly, we select representative claim 48 to decide the appeal of these claims, remaining claims standing or falling with claim 48.

Appellant argues that

...each of claims 48, 49, 50, 53, 57, 58, 59, and 60 recites, inter alia, that the financial institution issues the generated validation number to the check payor (over the Internet, for example) to allow the check payor to associate the issued validation number with the check to be presented from the check payor to the check payee. In this regard, Applicant submits that since Talati does not even disclose the financial institution generating a validation number in response to a determination being made that an account contains sufficient funds, Talati cannot disclose the financial institution issuing such a validation number to a check payor. (Appeal Br. 8)

We disagree with Appellant because in an alternative embodiment, Talati discloses “parties other than the originator 50 may create the UTID”, e.g., the credit authority 60 party. (FF 2) According to Talati, a credit authority 60 can process the credit request from the client 50 to determine the validity of the client 50 and the associated amount. (FF 2) The credit authority can then send, in the case where appropriate, both a credit approval and the UTID back to the client. (FF 2) We thus find that Talati discloses issuing a UTID, or a validation number, when the client credit line is sufficient to cover the monetary amount of the transaction to be processed. We further find that a credit authority is a financial institution because a bank, which is described in the Specification as a financial institution (Specification 3:6), is in the business of offering credit.

While the credit authority embodiment in Talati discussed above does not necessarily connote an account with funds, we do not find this problematic because the rejection is made under 35 U.S.C. § 103(a) also using Chang which discloses an account with funds, rather than using credit for payments. (FF 1) Moreover, Chang discloses that the payor bank 206 first determines whether the payor's account has sufficient funds to cover the amount, and then generates one or more electronic checks on behalf of the payor 202. (FF 1) Thus, Chang also discloses a determining step based on if an account contains sufficient funds to cover the monetary amount of the check to be presented from the check payor to the check payee.

Appellant asserts that Talati fails to disclose items (i) and (ii) set forth on page 8 of his Brief. However, that argument is not well taken because the

Appellant is attacking the Talati reference individually when the rejection is based on a combination of references with Chang disclosing the required funded account, and Talati disclosing the required financial institution generating a validation number when a determination is made. *See In re Keller*, 642 F.2d 413, 426 (CCPA 1981); *In re Young*, 403 F.2d 754, 757-58 (CCPA 1968).

Appellant's remaining arguments are based on the overlying argument that because Talati fails to disclose "the financial institution generating a validation number in response to a determination being made that an account contains sufficient funds, Talati cannot disclose..." the further limitations tied to the validation number. However, since these arguments do not advance Appellant's position beyond that offered above, which we found unpersuasive, we likewise find the latter arguments unpersuasive.

CONCLUSIONS OF LAW

We conclude the Appellant has not shown that the Examiner erred in rejecting claims 48, 49, 50, 53, 57, 58, 59, and 60.

DECISION

The decision of the Examiner to reject claims 48, 49, 50, 53, 57, 58, 59, and 60 is Affirmed.

AFFIRMED

Appeal 2009-9107
Application 10/022957

JRG

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